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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,122	08/18/2003	David H. Sprogis	5014CON	3473
55740 7590 07/09/2008 GAUTHIER & CONNORS, LLP 225 FRANKLIN STREET SUITE 2300 BOSTON, MA 02110				
EXAMINER				
CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				
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07/09/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/643,122

**Applicant(s)**

SPROGIS, DAVID H.

**Examiner**

Jeffrey D. Carlson

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/DE)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/07/2003, 10/25/2004, 06/27/2005, 10/31/2005, 07/07/2006, 12/12/2006, 08/17/2007.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-4, 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 (lines 11-12), there is no antecedent basis for said show schedule information.
- Claims 14-19 are system (apparatus) claims, yet they include many features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. A claim covering both an apparatus and a method of using that apparatus is invalid because such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous." MPEP 2173.05(p)(ii).
- Claim 16, there is no antecedent basis for the second subset of content data.
- Claim 16, there is no antecedent basis for the second subset of context data.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3-6, 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabowsky (6,141,530) in view of Zigmond et al (6,698,020)**

4. Regarding claims 1, 3-6, 8, 9, 11-19, Rabowsky discloses a system and method for providing advertisement information to an audience. In particular, Rabowsky teaches that cinema files are digitized and distributed to theaters electronically for playback. An automated scheduling system is provided in order to automatically play selected advertising with the actual timed movie showings [abstract, 1:61 to 2:5, 7:37-49, 12:8-29]. Rabowsky is taken to provide an enabling disclosure for compiling and assembling a presentation data package (ads + movie) at the headend. Rabowsky states the ability to request headend changes such as insertion of ads targeted to the theater location, yet it is not clear whether the targeted ads are manually or automatically selected and compiled. While Rabowsky teaches the ability to compile a collection of scheduled ads and the movie for each showing, he does not teach how and which particular ads are chosen for inclusion into the compiled presentation data package. While Rabowsky's movie advertising schedule is clearly automated in terms of playback, he lacks specific teachings for automating the selection of scheduled ads; it

is unclear how the ads are chosen for inclusion in the schedule. Zigmond et al teaches a system where video programming is provided with selected targeted advertising. Zigmond et al teaches that conventional prior art systems choose targeted ads based upon location [2:40-43] and that targeted ads can also be selected based upon the content of the video programming, location of the showing, characteristics of the viewer, local time, etc. and then subsequently displayed at the appropriate time [4:25-48]. This selection is accomplished by automatically comparing criteria (that has been entered/input and stored) regarding the audience, showing location and matching that with (input and stored) advertisement metadata/criteria representing the type of audience, type of location, etc. desired by each stored advertisement submitted by the advertiser [col 10-12]. This provides a system whereby job requests are submitted and the system automatically selects appropriately targeted ads for each movie showing. It would have been obvious to one of ordinary skill at the time of the invention to have created the advertising schedule of Rabowsky using similar techniques (matching stored context metadata concerning the movie content, its showing location, time, audience, etc., with stored metadata describing each stored advertisement) so that an appropriate subset of the advertisement collection can be associated and compiled with each actual movie showings. This would provide a more compelling advertisement experience likely to be more well received by the audience than untargeted ads, and would provide a system whereby administrators only need to specify targeting parameters/context/metadata rather than manually build each presentation data package for every movie showing. Regarding the particular collection of servers,

subservers, WAN, LAN, etc, clearly the theaters and projectors of Rabowsky are connected via networking to the central host. It would have been obvious to one of ordinary skill at the time of the invention to have provided any number of and configuration of servers, subnets, via WAN/LAN in order to provide an efficient and state of the art network capable of accepting job requests, downloading presentations and uploading result data. Rabowsky also teaches the concept of receiving feedback from the theater (i.e. the projectors) regarding a log of presentations (trailers) [7:38-42, 12:30-35].

5. Regarding claim 10, when the automated scheduling system creates a presentation (set of trailers) matched to the movie showing, it can be said that the system provides a means for determining whether the job request will be filled. Further, each of the finite collection of theater projectors and their finite collection of movie showtimes can only support a finite collection of trailers (assuming the desired duration for showing trailers is finite). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have set limits for accepting advertising trailers for display and obvious to determine which job requests can be filled and which cannot.

**6. Claims 2, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabowsky (6,141,530) in view of Zigmond et al (6,698,020) and Hunter (US6424998).**

7. Regarding claims 2, 7, Hunter teaches remote distribution of advertising over a network to be displayed at screen locations, including locations inside a movie theater

[abstract, 3:58-67]. Hunter further teaches that an advertiser uploads the advertising content to a central host where a subset of the content is automatically selected for display on a remote screen location at a certain time. Importantly, Hunter teaches that the advertising is reviewed before security and appropriateness standards prior to being used by the server. It would have been obvious to one of ordinary skill at the time of the invention to have reviewed the advertising of Rabowsky in order to avoid inappropriate advertising content from being shown on the screens of Rabowsky.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc